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PATENT
Attorney Docket No. SEL 125

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
Shunpei Yamazaki, et al.)
Serial No.: 09/255,605)
Filed: February 22, 1999)
Examiner: Vincent E. Kovalick)
Art Unit: 2673)
For: INFORMATION PROCESSING DEVICE)

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04-14-2005

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RESPONSE G (AFTER FINAL)

Dear Sir:

Applicants have the following response to the Final Rejection of January 12, 2005.

In the Final Rejection, the Examiner has the following rejections under 35 USC §103(a):

- A. Claims 1, 7, 13 and 19-26 are rejected as being unpatentable over Schoolman (US 5,281,957) taken with Yamauchi et al. (US 5,276,471) in view of Catallo et al. (US 5,867,817) taken with Riley (US 5,146,267) in further view of Miller (US 5,784,569).
- B. Claims 2 and 4 are rejected as being unpatentable over Schoolman taken with Yamauchi et al in view of Catallo et al taken with Riley further in view of Miller et al. and further in view of Funai et al. (US 6,162,667).
- C. Claims 3, 9 and 15 are rejected as being unpatentable over Schoolman taken with Yamauchi et al in view of Catallo et al taken with Riley further in view of Miller et al. taken with Funai and further in view of Oka et al. (US 6,235,563).
- D. Claims 5, 11 and 17 are rejected as being unpatentable over Schoolman taken with Yamauchi et al in view of Catallo et al taken with Riley further in view of Miller et al. and further in view of Intriligator (US 6,163,323) taken with Lewis (US 6,040,812).

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- E. Claims 6, 12 and 18 are rejected as being unpatentable over Schoolman taken with Yamauchi et al in view of Catallo et al taken with Riley further in view of Miller et al. and further in view of Nishi et al. (US 5,541,747).
- F. Claims 8, 10, 14 and 16 are rejected as being unpatentable over Schoolman taken with Yamauchi et al in view of Catallo et al taken with Riley further in view of Miller et al. and further in view of Funai et al.

Each of these rejections is respectfully traversed.

In particular, in the Final Rejection, the Examiner is now rejecting each of the claims over 5 or more different references. It is respectfully submitted that the Final Rejection fails to present a prima facie case of obviousness. Rather, the rejections appear to be based on hindsight reconstruction which is improper.

Under 35 U.S.C. §103, the burden is on the PTO to produce evidence that the claimed invention is prima facie obvious. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). If the PTO fails to make out a prima facie case of obviousness, then the rejection is improper, should be overturned, and Applicants are entitled to a patent. Rijckaert, 9 F.3d at 1532, 28 USPQ2d at 1956; In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1984); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). A prima facie of obviousness cannot be based on a combination of references wherein the combinations of references is based on hindsight reconstruction using the claimed invention as a template. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992); In re Oetiker, 24 USPQ2d 1443, 1444-1446 (Fed. Cir. 1992).

In the present application, each time Applicants have responded to a new rejection of the claims (and a new combination of references) and added a further element in order to claim the present invention in more detail, the Examiner appears to have searched for that particular

element and then stuck a reference that allegedly shows that element into the list of references that he has combined to arrive at the claimed invention and stated that it would have been obvious to do so. As a proper motivation has not been provided for such a combination of references, it is respectfully submitted that the combinations and rejections are based on improper hindsight reconstruction.

For example, independent Claim 1 is directed to an information processing device comprising: a display device having flat panel displays for right and left eyes mounted on the head of a user; a controller which transmits a first information to at least one of said flat panel displays to display said first information; an input operation device connected to said controller; and a camera provided over said input operation device, wherein said controller transmits a signal in the form of an electric wave to said display device and wherein said flat panel displays are capable of displaying a plurality of pieces of information at a time, wherein said display device, said controller, said input operation device and said camera are adapted to be used by the same user, and wherein an image second information different from said first information is transmitted from a TV tuner to said at least one of said flat panel displays to display said image second information.

In response, the Examiner has combined a reference for a portable computer and head mounted display (Schoolman) with an image displaying device (Yamaguchi) with a speech recognition device (Catallo) with a reflectance based microfilming process (Riley) with an arbitration procedure for selecting among devices in a computer system requesting access to a single resource (Miller), and stated that Schoolman taken with Yamaguchi in view of Catallo taken with Riley teach a head mounted display comprising separate LCD's for each of the right and left eyes with the means to receive wireless input signals, with a camera at the disposal of

the user, with the features of Miller to put all the elements of the system, e.g. the display device, controller, input operation, device, camera at the disposal of the system user.

However, it appears that the Examiner is creating this “system” based on the claims of the present application and that there is no teaching or motivation in the references to combine them to create the alleged “system.”

For example, while Schoolman, Yamaguchi and Catallo are directed to a head mounted display, Riley is directed to a microfilming work station. Such a workstation has a microfilming camera above a filming position on a cabinet with a pair of flood lamps for illuminating the filming position and an exposure meter (see Fig. 1 in reference). The reference is then directed to a process for microfilm recording which is done on such a work station. There is no teaching or motivation for one skilled in the art to combine the three references (Schoolman, Yamaguchi and Catallo) directed to a head mounted display with a camera from a microfilming work station to arrive at the claimed information processing device of the claimed invention, except by hindsight reconstruction, using the claim as a template. Further, it is respectfully submitted that the statement in the Office Action that “[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to provide to the device as taught by Schoolman taken with Yamaguchi et al. in view of Catallo et al. the features as taught by Riley in order to put in place an image pick-up device that would take in a defined field of view” is not an acceptable motivation but also appears to be hindsight reasoning as it provides no logical reason why one would add a camera to the device of the combined references (other than it is in the claimed invention).

As the Federal Circuit stated in McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008, (Fed. Cir. 2001), “[t]he genius of invention is often a combination of known elements

which in hindsight seems preordained.” As a result, “[I]t is impermissible to use the claimed invention as an instructional manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” In re Fritch, 972 F.2d at 1266, 23USPQ2d at 1784. Combining references in a manner that reconstructs the applicant’s invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. In re Octiker, 24 USPQ2d at 1444-1446 (Fed. Cir. 1992).

Accordingly, for at least the above-stated reasons, the rejection of independent Claim 1 of the present application is improper and should be withdrawn.

For similar reasons, the rejections of the other claims of the present application are also improper and should be withdrawn.

Information Disclosure Statement

Applicants are also preparing an Information Disclosure Statement (IDS) and will submit it very soon. It is respectfully requested that this IDS be entered and considered prior to the issuance of any further action on this application.

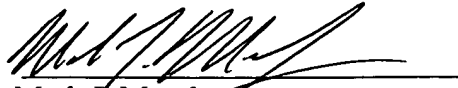
Conclusion

Accordingly, it is respectfully submitted that the present application is in a condition for allowance and should be allowed.

If any further fee is due for this response, please charge our deposit account no. 50-1039.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,


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